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Art Unit 2183,	Telephone No.: 571 272 3595	
U.S. Patent and Trademark Office	City: Alexandria	State: Virginia

CONCERNING APPLICATION:

Applicant(s): John S. Yates, Jr., et al.

Serial No.: 09/385,394

Art Unit: 2183

Filed: August 30, 1999

Examiner: Richard Ellis

Title: COMPUTER WITH TWO EXECUTION MODES

AFTER FINAL - EXPEDITED PROCEDURE

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PATENT

ATTORNEY DOCKET NO. 114596-03-4000

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Serial No.: 09/385,394
 Applicant: John S. Yates, Jr., et al.
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 Art Unit: 2183
 Examiner: Richard Ellis
 Atty. Docket: 114596-03-4000
 Customer No. 38492

Confirmation No.: 9093

OCT 31 2005

AFTER FINAL - EXPEDITED PROCEDURE**SUPPLEMENT TO PETITION**

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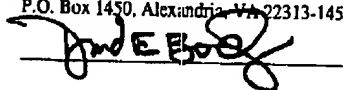
In view of a brief telephone interview with T.C. Director Jack Harvey, October 31, 2005, Petitioner submits information that may be useful in reconsideration of the existing Petition (originally filed 4/8/05, supplemented 6/14/05).

I. Summary of Interview With T.C. Director Harvey

Petitioner thanks T.C. Director Jack Harvey for a brief telephone interview of October 31, 2005.

Petitioner observed that the fundamental problem with this application is that Examiner Ellis has been playing "hide the ball." In spite of repeated requests in Petitioner's papers, with

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Supplement to Petition
 This paper dated October 31, 2005

1

114596-03-4000 S/N 09/385,394
 3037699.2

BEST AVAILABLE COPY

Application Serial No. 09/385,394
Attorney Docket No. 114596-03-4000
Supplement to Petition – this paper dated October 31, 2005

specific citation to rules that require an Examiner to put certain findings to paper, Examiner Ellis simply refuses to timely disclose his views. Claim limitations are ignored until final Office Actions and post-final advisory actions, and entirely new theories are raised in those papers. On several occasions, Examiner Ellis has directly stated that he will not follow instructions set out by Director Dudas in 37 C.F.R. and the MPEP. Even though he plainly admits in his advisory actions that his Office Actions have been incomplete, and that he “completely misunderstood” the invention he was examining, he insists on maintaining finality of those Office Actions.

In the interview, it was agreed that the Decision of 9/9/05 was withdrawn, because it was issued beyond the authority of a SPrE – the signature of a T.C. Director is required. MPEP § 1002.02. It was agreed that a new decision would be issued.

Petitioner and Director Harvey discussed the definition of the term “new ground of rejection.” Director Harvey stated that he understood the term to require either a shift of statutory section, or a new reference. Petitioner noted that the CCPA cases cited in the Petition specifically rejected this view (indeed, as discussed below, the Federal Circuit rejected the PTO’s view yet again in a decision of August 2005, *In re Kumar*, 418 F.3d 1361, 1367, 76 USPQ2d 1048, 1052 (Fed. Cir. 2005) (rejecting PTO’s “simply an additional explanation” of existing references as a definition of “new ground”)). Petitioner suggested that it would be appropriate to include a citation to authority for whatever definition of “new ground” would be used in further proceedings. Director Harvey indicated that he would attempt to locate one, and that he believed it existed in the MPEP.

II. Definition of the Legal Term of Art “New Ground of Rejection”

In an effort to assist Director Harvey and SPrE Johnson in their reconsideration of the Petition now pending, Petitioner notes the following.

The legal term “new ground of rejection” is defined as any “position or rationale new to the proceedings” (new evidence, citation to a new portion of existing evidence, a new inference drawn from an existing reference, a new legal theory, a new application of law to facts, etc.)¹.

¹ *In re DeBlauwe*, 736 F.2d 699, 706 n. 9, 222 USPQ 191, 197 n.9 (Fed. Cir. 1984) (“Where the board makes a decision advancing a position or rationale new to the proceedings, an applicant must be

Application Serial No. 09/385,394
 Attorney Docket No. 114596-03-4000
 Supplement to Petition - this paper dated October 31, 2005

For example, relying on a new portion of an existing reference is a "new ground of rejection."²
 A new factual finding or inference drawn from the identical portions of existing references is a
 "new ground of rejection."³ A new supporting position or rationale is a "new ground," even if it
 is simply offered to buttress a previous analysis or inference.⁴ Any notion that a "new ground"

afforded an opportunity to respond to that position or rationale by submission of contradicting evidence").
citing 37 C.F.R. § 1.196(h); *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426 (CCPA 1976); *In re Eynde*, 480 F.2d 1364, 1370-71, 178 USPQ 470, 474 (CCPA 1973) ("We do agree with appellants that where the board advances a position or rationale new to the proceedings... the appellant must be afforded an opportunity to respond to that position or rationale by the submission of contradicting evidence. This court so held in *In re Moore*, [444 F.2d 572, 170 USPQ 260 (CCPA 1971)], and we expressly reaffirm that view. The board's refusal to consider evidence which responds to such a new rationale is error."); *Ex parte Teeple*, Appeal No. 97-0943, 1997 WL 1883925 at *2-3, <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd970943.pdf> at 7, 9 (BPAI Feb. 17, 1998) (new explanation for § 112 ¶ 2 rejection of same claim language is "new ground" of rejection).

² *In re Wiechert*, 370 F.2d 927, 933, 152 USPQ 247, 251-52 (CCPA 1967) ("An applicant's attention and response are naturally focused on that portion of the reference which is specifically pointed out by the examiner. ... [W]hen a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-à-vis such portion of the reference"); *see also In re Echerd*, 471 F.2d 632, 635, 176 USPQ 321, 323 (CCPA 1973) ("We find the new reliance [to be] a new ground of rejection. New portions of the reference are relied upon to support an entirely new theory... appellants should have been accorded an opportunity to present rebuttal evidence as to the new assumptions of inherent characteristics made by the board"), *reaffirmed by Kronig*, 539 F.2d at 1303, 190 USPQ at 427. The PTO's more-recent decisions regularly reinforce this principle. *E.g.*, *Ex parte Kelcher*, Appeal No. 1999-1899, 2002 WL 63644 at *3-4, <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd991899.pdf> at 9-10 (BPAI Feb. 28, 2001) (new reliance on an arrow in a figure of an existing reference is a "new ground of rejection"); *Ex parte D'Andrade*, Appeal No. 1999-1235, 1999 WL 33224326 at *3, .../fd991235.pdf at 7, 10 (BPAI Sep. 30, 1999) (shift from examiner's reliance on tension spring 59 to Board's reliance on tension spring 61 in the same single reference is a "new ground of rejection"); *In re Intine*, 162 USPQ 192, 192 (Comm'r of Patents 1969) (a shift from references A and B to references A, B and C, where C had previously been relied upon, prevented final rejection).

³ *In re Moore*, 444 F.2d 572, 574-75, 170 USPQ 260, 263 (CCPA 1971) (any new "finding of a new fact," even from the same reference, even solely in support of an alternative to the pre-existing rationale, requires that the applicant be given an opportunity to respond), *reaffirmed by Kronig*, 539 F.2d at 1303, 190 USPQ at 427.

⁴ *In re Kumar*, 418 F.3d 1361, 1367, 76 USPQ2d 1048, 1051 (Fed. Cir. 2005) (a new calculation applied to a reference is not "simply an additional explanation of the Board's decision," it is a new ground of rejection); *In re Waymouth*, 486 F.2d 1058, 1061, 179 USPQ 627, 629 (CCPA 1973) ("merely advanc[ing] 'an additional reason' for affirming the examiner" is a "new rejection"), *modified* 489 F.2d 1297, 180 USPQ 453 (CCPA 1974), *reaffirmed by Kronig*, 539 F.2d at 1303, 190 USPQ at 427; *Moore*, 444 F.2d at 574-75, 170 USPQ at 263, *reaffirmed by Kronig*, 539 F.2d at 1303, 190 USPQ at 427; *Ex parte Lachut*, Appeal No. 2001-0933, 2002 WL 31257834 at *5, <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd010933.pdf> at 9 (BPAI Mar. 14, 2002) (new analysis and inferences drawn from the same portion of Hazen reference is a new point); *Ex parte Hanlon*, Appeal No. 98-2033, 1998 WL

Supplement to Petition
 This paper dated October 31, 2005

3

114596-03-4000 S/N 09/385,394
 3037699.2

Application Serial No. 09/385,394
 Attorney Docket No. 114596-03-4000
 Supplement to Petition – this paper dated October 31, 2005

requires a new reference or shift from one statutory section to another has been expressly rejected by the courts and by the Federal Circuit, the CCPA, and the Board.⁵

The reason follows from basic principles of examination: it is always the examiner's duty to take the first step of stating all elements of a *prima facie* case of unpatentability.⁶ For example, 37 C.F.R. § 1.104(c)(2) states that it is the examiner's duty in the first instance to designate the portions relied upon "as nearly as practicable," and "clearly explain" the correspondence of any complex reference to any claim being rejected, at least on the facts here.⁷ The courts and the Board have noted that Applicants cannot, and therefore are not obligated to, respond to issues that the examiner has not raised. See 37 C.F.R. § 1.111(b) (response must "point[] out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action" – no duty to go beyond the written action). Applicants are under no duty to anticipate issues that an examiner could have raised – even should have raised – but did not – and whenever an examiner raises such issues, they are "new grounds."⁸

1748535 at *2-3, .../fd982033.pdf (Board's different analysis of the same portion of the same reference is a "new ground of rejection").

⁵ *In re Kumar*, 418 F.3d 1361, 1367, 76 USPQ2d 1048, 1051 (Fed. Cir. 2005); *In re Ahlert*, 424 F.2d 1088, 1098, 165 USPQ 418, 421 (CCPA 1970) (new facts based on an existing reference are a new ground of rejection, even if cast as "official notice"); *In re Bulina*, 362 F.2d 555, 558-59, 150 USPQ 110, 113 (CCPA 1966), *reaffirmed by Kronig*, 539 F.2d at 1303, 190 USPQ at 427; *In re Intine*, 162 USPQ 192, 192 (Comm'r of Patents 1969).

⁶ 35 U.S.C. § 102 (patent "shall" be granted, "unless" PTO establishes unpatentability); 37 C.F.R. §§ 1.104, 1.113 (actions must be "complete" and "clearly state" reasons); MPEP § 2142 (burden rests with examiner to "show" unpatentability); 5 U.S.C. §§ 551-559; *Wiechert*, 370 F.2d at 963-64, 152 USPQ at 251-52, *citing* 37 C.F.R. § 1.106, now § 1.104(c)(2); *see also In re Oetiker*, 977 F.2d 1443, 1449 (Fed. Cir. 1992) (Plager, J., concurring) ("The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner.").

⁷ *See also Wiechert*, 370 F.2d at 963-64, 152 USPQ at 251-52 ("This point seems to be appreciated by the Patent Office itself as its Rule 106(b) [now 1.104(c)(2)] provides, *inter alia*, that: "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.").

⁸ *Wiechert*, 370 F.2d at 933, 152 USPQ 251-52 (applicants "cannot practically" address all that "might be mentioned in a particular reference"); *Ex parte Lachua*, Appeal No. 2001-0933, 2002 WL 31257834 at *5, <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd010933.pdf> at 9 (BPAI Mar. 14, 2002) ("The entire [new analysis of existing references] is new and should have and could have been raised earlier," underline added); *see also Ex parte Mehta*, Appeal No. 1999-2683, 2002 WL 1801560 at

Supplement to Petition
 This paper dated October 31, 2005

4

114596-03-4000 S/N 09/385,394
 3037699.2

Application Serial No. 09/385,394
Attorney Docket No. 114596-03-4000
Supplement to Petition – this paper dated October 31, 2005

The rules provide only one procedural course when an applicant's arguments or evidence require a new position or rationale from an examiner: non-final rejection. Applicants must be given a fair opportunity to react to the thrust of any new ground, regardless of the time or context in which the examiner's "new position or rationale" arises. For example, if the new ground is introduced in response to an applicant's showing that an old ground of rejection is weak, any shift or buttressing is still a "new ground," and the applicant must be given full opportunity to respond.⁹

"Contrary to the citations of case law ... it cannot be seen" (Decision of 9/9/05, page 5, line 15) is not an appropriate basis on which to disregard court and agency precedent, *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) ("An agency is not free to refuse to follow circuit precedent."), especially where the "new ground" case law focuses entirely on an applicant's opportunity to respond to an examiner, and never mentions the *vice versa* situation discussed in the 9/9/05 Decision.

Director Harvey stated that, on reconsideration, he would rely on any definition stated in the MPEP. But the PTO has never taken the view that the MPEP can overrule the Federal Circuit. As the MPEP itself concedes, the MPEP has no "force of law" and cannot be interpreted contrary to 37 C.F.R. or Federal Circuit law. MPEP Forward; *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1425 (Fed. Cir. 1988) (MPEP "does not have the force of law, but it 'has been held to describe procedures on which the public can rely.'")

*4, .../fd992683.pdf at 11 (BPAI Jul 30, 2001) (Board rejects examiner's attempt to untimely "twist the rejection around," even though based on the same references).

⁹ *In re Eynde*, 480 F.2d 1364, 1371, 178 USPQ 470, 475 (CCPA 1973) (even though Board's new rationale, based on the Eynde patent, was in response to arguments made in the appeal Reply Brief, it was nonetheless a "new ground"), *reaffirmed by Kronig*, 539 F.2d at 1303, 190 USPQ at 427; *Ex parte Kozek*, Appeal No. 95-4678, 1995 WL 1747751 at *3-4, <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd954678.pdf> at 7-9 (BPAI Sept. 16, 1997) (expressly acknowledging that appellant's argument overcomes the examiner's stated reasons, but entering a "new ground of rejection" based on a different analysis of the identical references).

Application Serial No. 09/385,394
 Attorney Docket No. 114596-03-4000
 Supplement to Petition – this paper dated October 31, 2005

III. The Facts Are Not In Dispute: The New Positions and Rationales in the 10/25/04 Office Action, the 2/14/05 Advisory Action, and the 6/14/05 Advisory Meet the Legal Definition of “New Ground”

The relevant facts are set forth in the Petition of 4/8/05. There is no question that:

- Paragraph 14.4 of the 10/25/04 Action is the first mention in the prosecution history of Brender, col. 15, lines 48-50, and the first attempt to “designate” any portion of any reference as corresponding to the “control transfer instruction” of claim 87.
- Paragraph 3 of the Advisory of 2/14/05 is the first mention of Goetz, col. 15 lines 45-49 in the prosecution history.

Under the correct definition of “new ground,” there is really no question that these are two “new grounds of rejection.” See Petition of 4/8/05, Supplement of 6/14/05.

IV. The 9/9/05 Decision Overlooked an Issue that was Presented: Both Office Actions are Too Incomplete to Support Final Rejection

Section I.E of the 4/8/05 Petition (pages 6-7) raises a separate ground for withdrawing finality based on MPEP §§ 2142-2143.03. The 9/9/05 Decision appears to have overlooked this issue. That discussion is repeated here:

The Director instructs, as a matter of “procedure,” that the examiner bears the initial burden to come forward with three showings to support any rejection for obviousness:

2142 Legal Concept of *Prima Facie* Obviousness

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. ... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. ...

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. ... Second, there must be a reasonable expectation of success.¹⁰

...
 The Examiner disagrees with the Director. In spite of several requests by Petitioner for some showing of “reasonable expectation of success,” the Examiner

¹⁰ MPEP § 2143 and 2143.02 restate an obligation placed on examiners by the Federal Circuit: “A proper analysis under § 103 requires, *inter alia*, consideration of ... whether ... those of ordinary skill would have a reasonable expectation of success.” *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

Application Serial No. 09/385,394
 Attorney Docket No. 114596-03-4000
 Supplement to Petition - this paper dated October 31, 2005

refuses to provide any such showing. Indeed, in the paper of February 10, 2003, Examiner Ellis states that he believes that "reasonable expectation of success" only applies in the chemical arts. Examiner Ellis states no authority for his opinion. Both the Director and the Federal Circuit instruct otherwise. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) (directly rejecting argument that *prima facie* obviousness applies only in chemical arts).

Differences of opinion between an examiner and the Director's policies set out in the MPEP are petitionable.⁴ Further, where an examiner has been totally silent, it is impossible to identify what difference of opinion might exist between applicant and examiner, let alone appeal that difference. Until all required elements of an examiner's analysis are set down on paper, closure of prosecution is premature.

⁴ ... *In re Alappat*, 33 F.3d 1527, 1580, 31 USPQ2d 1545, 1588 (Fed. Cir. 1994) (*en banc*) (Plager, J., concurring) ("The [Director] has an obligation to ensure that all parts of the agency ... conform to official policy of the agency..."); see also *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1284-85, 73 USPQ2d 1409, 1414-15 (Fed. Cir. 2005) ("petition process [is] the 'exclusive administrative check' on the discretion of examiners," to ensure that examiners act within the PTO's rules); *Ex parte Haas*, 175 USPQ 217, 220 (Bd. Pat. App. 1972) ("If the examiner fails to follow the Commissioner's directions in the M.P.E.P., appellant's remedy is by way of petition to the Commissioner since this Board has no jurisdiction over the examiner's action.") (Lidoff, examiner-in-chief, concurring), *rev'd on other grounds*, 486 F.2d 1053 (CCPA 1973).

Those who decide Petitions are obligated to decide all issues presented. Separate grounds may not be ignored, and the issues may not be redefined. *E.g.*, *In re Kumar*, 418 F.3d 1361, 1367, 76 USPQ2d 1048, 1052 (Fed. Cir. 2005) ("In accordance with the Administrative Procedure Act, the agency must assure that an applicant's petition is fully and fairly treated at the administrative level, without interim need for judicial intervention.").

Because The 9/9/05 Decision failed to decide this issue, the Decision is vacant *ab initio*. The Office may not pick and choose which rules it chooses to enforce and those it chooses to ignore when enforcement is sought.

Petitioner respectfully requests that if the Petition is denied, that all grounds raised be addressed.

V. The Status of Claim 22 is Too Unclear to Permit Appeal or Closure of Prosecution

The Petition of 4/8/05 (as supplemented 6/14/05) raises several related issues as to Claim 22, all arising under 37 C.F.R. § 1.113(b) and MPEP § 706.07, which address "clarity" and

Supplement to Petition
 This paper dated October 31, 2005

7

114596-03-4000 S/N 09/385,394
 3037699.2

Application Serial No. 09/385,394
Attorney Docket No. 114596-03-4000
Supplement to Petition – this paper dated October 31, 2005

“completeness.” The 9/9/05 Decision apparently overlooks these issues as well. Instead, the Decision appears to be directed to an issue under MPEP § 706.07(a), relating to “new ground of rejection.” See Decision of 9/9/05, statement of issues decided, page 3, second item. Neither 37 C.F.R. § 1.113(b) nor MPEP § 706.07 contain any mention of “new grounds of rejection” – that is an unrelated issue. Therefore, it is clear that the issue presented was never decided.

A. Procedural History of Claim 22

Claim 22 is discussed at paragraph 52 of the Office Action of the 2/11/04 and paragraph 14 of the 10/25/04 Office Action. Claim 22 recites as follows:

22. A method, comprising the steps of:

executing instructions fetched from first and second regions of a memory of a computer, the instructions of the first and second regions being coded for execution by computers following first and second data storage conventions, the memory regions having associated first and second indicator elements, **the indicator elements each having a value indicating the data storage convention under which instructions from the associated region are to be executed;**

recognizing when program execution has flowed or transferred from a region whose indicator element indicates the first data storage convention to a region whose indicator element indicates the second data storage convention, and in response to the recognition, altering the data storage content of the computer to create a program context under the second data storage convention that is logically equivalent to a pre-alteration program context under the first data storage convention.

Paragraph 52.4 of the 2/11/04 Action compares the “the indicator elements each having a value indicating the data storage convention under which instructions from the associated region are to be executed” to only Goetz '913, col. 17, lines 24-33 and to no other reference (¶¶ 52.3 and 52.5 also only mention the Goetz '913 reference, making clear that Examiner Ellis is relying exclusively on one reference for this portion of the claim):

52.	As to claim 22, Goetz et al. in view of Brender et al. and Murphy et al. taught:
52.4.	the indicator elements each having a value indicating the data storage convention under which instructions from the associated region are to be executed (Goetz et al. col. 17 lines 24-33);

Petitioner's paper of 7/12/04 fully responded to the issue as presented, by showing that the Examiner's interpretation of Goetz '913, col. 17, lines 24-33 is incorrect.

Supplement to Petition
This paper dated October 31, 2005

8

114596-03-4000 S/N 09/385,394
3037699.2

Application Serial No. 09/385,394
Attorney Docket No. 114596-03-4000
Supplement to Petition – this paper dated October 31, 2005

Though this showing has been before Examiner Ellis on at least three occasions, (Response of 7/12/04, pages 34-35; Response to Office Action of 1/25/05 at pages 35-36; Second Response of 4/14/05 at pages 49-52), there has been no reply from Examiner Ellis. Examiner Ellis has not explained whether he maintains his original view, agreed with the showing, or has changed positions.

Instead, the 10/25/04 Action states that the Examiner has shifted from the single Goetz reference to another, and that because of that shift, “references may not be attacked individually.” However, the 10/25/04 Action does not even specify which other references might be involved, let alone “designate the portions relied on” as required by 37 C.F.R.

§ 1.104(c)(2) (Action of 10/25/04, page 3 ¶ 14.1):

14.1. That: “Paragraph 52.4 compares the “the indicator elements each having a value indicating the data storage convention under which instructions from the associated region are to be executed” to Goetz, col. 17, lines 24-33. However, here, Goetz only teaches a P bit that indicates an instruction set. There is no indication that Goetz ever uses two different “data storage conventions” as recited in claim 22, let alone indicates them with any “indicator.”

This is not found persuasive because applicant is arguing against the references separately. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Paragraph 4 of the 2/14/05 Advisory Action further confuses the issues: it merely states that unspecified portions of one or both of two other references might be used to supplement the Goetz '913 patent, in some unspecified way, to meet the specific claim limitation at issue:

Supplement to Petition
This paper dated October 31, 2005

9

114596-03-4000 S/N 09/385,394
3037699.2

Application Serial No. 09/385,394
 Attorney Docket No. 114596-03-4000
 Supplement to Petition – this paper dated October 31, 2005

4. **"No "Clear Issue" Is Developed for Claim 22"**

Applicant is additionally in error in this statement. If applicant were to have referred to the rejection of claim 22 at paragraph 52 of the February 2004 office action, he would have recognized that the rejection of claim 22 was based upon a combination of references, specifically Goetz et al. in view of Brender et al. and Murphy et al. He would also have recognized from the rejection that although Goetz et al. contained the claimed indicators (52.4) that it was Brender et al. and Murphy et al. which provided the teaching of "data storage convention" portion of this particular claim. Therefore, by arguing that Goetz et al. alone did not teach the complete claimed aspect, applicant was indeed arguing the references individually, and as such, the response given was exactly that which was necessary to rebut applicant's argument.

The 6/14/05 Advisory Action offers no further clarification of what the Examiner's position is today, let alone "designate the portions relied on" as required by 37 C.F.R. § 1.104(c)(2).

B. Applicable Law

37 C.F.R. § 1.113 sets out the minimum requirements for a final rejection. Rule 113 reads as follows:

37 C.F.R. 1.113. Final rejection or action.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

MPEP § 706.07 elaborates on § 1.113 as follows, emphasis added:

706.07 Final Rejection

Before final rejection is in order a clear issue should be developed between the examiner and applicant. ...

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

....

In making the final rejection, all outstanding grounds of rejection ... must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

Supplement to Petition
 This paper dated October 31, 2005

10

114596-03-4000

S/N 09/385,394

3037699.2

Application Serial No. 09/385,394
Attorney Docket No. 114596-03-4000
Supplement to Petition – this paper dated October 31, 2005

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's reply.

C. Because There is No "Clear Statement of Reasons," Final Rejection is Premature

The 10/25/04 Office Action articulates no clear position on claim 22. Especially in view of the contradictory positions taken in the Final Action and Advisory Actions, there is no way to know:

- Does the Examiner still consider Goetz '913, col. 17, lines 24-33 to be pertinent?
- Does the Examiner agree or disagree with the showing in the Response of 7/12/04, that Goetz '913, col. 17, lines 24-33 does not show the "indicator elements ... having a value indicating the data storage convention under which instructions from the associated regions are to be executed?"
- What other references might be pertinent to the "indicator elements" of claim 22? The 10/25/04 Action and 6/14/05 Advisory suggests that other references might be pertinent, but does not designate which references, let alone "designate the particular portions relied on."

On the current state of the record, it is unclear whether the examiner relies on a single reference to meet the relevant limitation of claim 22, or on some combination. If the examiner relies on a combination, there is no statement of what that combination is. Without even an identification of what references are believed pertinent to the claim limitation at issue, it is impossible to identify whether the "issue for appeal" is:

- Do Applicant and Examiner agree or disagree on claim scope?
- Do Applicant and Examiner agree or disagree on the content of Goetz '913, col. 17, lines 24-33?
- Do Applicant and Examiner agree or disagree on the content of other unspecified references?
- Do Applicant and Examiner agree or disagree on the law of obviousness?
- Do Applicant and Examiner agree or disagree on the application of the law to the facts?

An appeal brief directed to claim 22 can only ask the Examiner to set forth his position – but 37 C.F.R. § 1.113 demands a statement no later than a final Office Action. Until the Examiner complies with the procedural requirements of 37 C.F.R. §§ 1.104(c)(2), by designating the

Supplement to Petition
This paper dated October 31, 2005

11

114596-03-4000 S/N 09/385,394
3037699.2

Application Serial No. 09/385,394
Attorney Docket No. 114596-03-4000
Supplement to Petition - this paper dated October 31, 2005

portions of each reference relied upon, and explaining the pertinence of these references, no substantive response is possible. An appeal brief cannot rebut showings that have not been made, or identify dependent claims that should stand or fall with claim 22.

Petitioner has challenged the PTO to identify even the portions of the references relied on by the examiner, and the elements of that art thought pertinent. Both Examiner Ellis and the 9/9/05 Decision are silent. The 9/9/05 Decision correctly states that Applicant "clearly" responded to the Examiner's initial position, but makes no attempt to identify any point at which the Examiner "clearly" states what his position is now, including a "designation" of the portions of the references now thought pertinent. If the point of disagreement is "clear," the PTO should be able to identify where the record sets out the Examiner's view, timely and clearly stated (including the Examiner's "Answer [of] All Material Traversed," as required by MPEP § 707.07(f)), and if it cannot, then the PTO should recognize that final rejection is premature.

VI. The 9/9/05 Decision Erred By Failing to Decide an Issue Presented Relative to Claim 104

The first full paragraph on page 9 of the 4/8/05 Petition states an issue arising under MPEP § 706.07; this issue is not decided in the Decision of 9/9/05. MPEP § 706.07 instructs that final rejection is only permissible when an examiner's position on each individual claim is articulated in a single paper, and his position on the application as a whole is set out in no more than two:

STATEMENT OF GROUNDS

...
However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's reply....

The 2/14/05 Advisory Action ¶ 3 squarely admits that the 10/25/04 Office Action was incomplete and unclear:

Applicant is additionally confused because paragraph 14.7 of the Office Action of October 2004 contains a copy of the response from paragraph 14.1 regarding claim 22. This

Supplement to Petition
This paper dated October 31, 2005

12

114596-03-4000 S/N 09/385,394
3037699.2

Application Serial No. 09/385,394
Attorney Docket No. 114596-03-4000
Supplement to Petition - this paper dated October 31, 2005

was a typographical mistake in the office action of October 2004. The correct response was:
Goetz et al. taught using "the instructions ... following first and second data storage
conventions" at col. 15 lines 45-49.

An Advisory Action is both an untimely place to state a new issue, and improper in its attempt to inject a third paper into any appeal. Thus, the procedural requirements for closing prosecution are not satisfied.

Until all issues are explained timely and "clearly" in no more than two papers, Rule 113 and MPEP § 706.07 make clear that closing of prosecution is premature.

V. Conclusion

For these reasons, the finality of the Action of 10/25/04 should be withdrawn. Prosecution should be reopened, and the Amendment filed 4/25/05 should be entered as of right (even without a showing of reasons under Rule 116). In the alternative, the Amendment of 4/14/05 should be entered pursuant to 37 C.F.R. § 1.116(b)(3). In either case, and in addition, Examiner Ellis should be instructed that he will not receive a disposal "count" until he mails two Office Actions that fully and fairly treat all claims (at least all independent claims) pending in the application, setting forth factual and legal findings on all issues instructed by the Director in 37 C.F.R. § 1.104 and MPEP Chapters 700 and 2100.

It is believed that this paper occasions no fee. Kindly charge any fee due to Deposit Account No. 23-2405, Order No. 114596-03-4000.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: October 31, 2005

By: 

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Supplement to Petition
This paper dated October 31, 2005

13

114596-03-4000

S/N 09/385,394
3037699.2

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